

REMARKS

Claims 2 and 15 have been amended to correct certain informalities. Applicant respectfully submits that the proposed amendments do not constitute new matter.

The Examiner objects to the drawings under 37 CFR §1.83(a) noting that the second sound conduction tube disclosed in claim 2 must be shown. Applicant traverses this objection. As noted below, claim 2 has been amended to remove the reference to a second sound conduction tube.

In claim 15, the Examiner objects to the use of the word "therein" in reference to the relationship between the electrical cable and the electrical connector. Applicant traverses this objection. Claim 15 has been amended to read "...an electrical connector attached thereto." This amendment is supported by the original specification at, for example page 4, line 24 to 25 and in the drawings in Figure 2. Applicant respectfully submits that the amendment does constitute an addition of new matter.

The Examiner rejects claim 2 under 35 U.S.C. §112, first paragraph as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to make and/or use the invention. Applicant traverses this rejection by amending Claim 2 to change the reference to the second sound conduction tube to "a housing, said housing snugly engaging said sound conduction tube and said electrical cable." This amendment is supported by the original specification at, for example, page 4, line 19 to 23. Applicant respectfully submits that the amendment does constitute an addition of new matter.

The Examiner rejects claims 1-13 under 35 U.S.C. §102(f), asserting that the applicant did not invent the claimed subject matter and noting that various aspects of the claims are listed in United States Patents No. 4,381,830, No. 5,753,870, and No. 5,975,235 on which Chester Jelonek is listed as a co-inventor. Applicant traverses this rejection as well as any potentially forthcoming 35 U.S.C. §102(b) rejections based on the cited references and respectfully refers the Examiner to §2137 of the M.P.E.P. As noted in the M.P.E.P., "the mere fact that a claim recites the use of various components, each of which can be argumentatively assumed to be old, does not provide a proper basis for a rejection under 35 U.S.C. §102(f)." *Ex Parte Billottet*, 192 USPQ 413, 415 (Bd. App. 1976). Likewise, as noted at §2131 of the MPEP, for a proper 35

U.S.C. §102(b) rejection, “a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”

Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

The Examiner asserts that the inventor did not himself invent certain portions of the electro-acoustic system of the present invention. However, as noted above, the standard for rejection under 35 U.S.C. §102(f) is “complete conception by another and communication to the alleged deriver.” MPEP 2137. Similarly, under 35 U.S.C. §102(b), all elements of the claimed invention must be disclosed in a single prior art reference. The cited references all teach various self-contained hearing aid devices, none of which include or suggest “an electrical cable having one end connected to the speaker for driving the speaker...” or “an electrical plug connected to another end of the electrical cable...”. Thus, Applicant respectfully submits that the Examiner has failed to make a *prima facie* case for either derivation or anticipation on the basis of the cited references. The rejected claims should therefore be in condition for allowance.

The Examiner rejects claims 1-4 and 14 under 35 U.S.C. §103(a) as being unpatenable over United States Patent No. 2,573,132 (French ‘132) in view of United States Patent No. 4,499,593 (Antle). Applicant traverses this rejection on the basis that the Examiner has failed to establish a *prima facie* case for obviousness. A proper case for *prima facie* obviousness requires some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to combine the referenced teachings. Applicant notes that the cited references fail this test. French ‘132 does not disclose a “fitted earmold” as the Examiner asserts. In fact, French ‘132 explicitly teaches against such an earmold at column 1, line 16 to 19. Court interpretations of 35 U.S.C. §103(a) have previously noted that teachings that counter a motivation to combine or modify references are powerful evidence of a lack of *prima facie* obviousness. Antle also provides no teaching or suggestion that would prompt one skilled in the art to modify French ‘132 to obtain the apparatus recited in claim 1. Furthermore, the limitation that “the passage is opposite the sound-conduction bore” is neither disclosed nor suggested in either cited reference.

With regards to claim 2, the amended recitation of “a housing, said housing snugly

engaging said sound conduction tube and said electrical cable" is not disclosed nor suggested in the teachings of either of the cited references. Claims 2-4 and 14 depend from claim 1 and thus incorporate the aforementioned limitations which fail the test of obviousness. Thus, Applicant respectfully submits that claims 1-4 and 14 are in condition for allowance.

The Examiner rejects claims 5-10 and 12-13 under 35 U.S.C. §103(a) as being unpatentable over United States Patent No. 2,573,132 (French '132), in view of United States Patent No. 4,499,593 (Antle), and in further view of United States Patent No. 5,753,870 (Schlaegel et al '870). The Examiner also rejects claims 5 and 11 and 12-13 under 35 U.S.C. §103(a) as being unpatentable over United States Patent No. 2,573,132 (French '132), in view of United States Patent No. 4,499,593 (Antle), and in further view of United States Patent No. 5,488,205 (Major). Applicant notes that the rejected claims are all dependent claims from independent claim 1. As Applicant has argued above, claim 1 is patentable over the cited art. Claims 5-13 all incorporate the patentable limitations of claim 1 and are thus also in condition for allowance.

Based on the foregoing, applicant respectfully submits that the application is now in condition for allowance. If any matters can be resolved by telephone, the Examiner is invited to call the undersigned attorney at the telephone number listed below.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is captioned "Version with markings to show changes made."

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication or credit any overpayment to our Deposit Account No. 06-1300 (Order No. A-65282/AJT).

Respectfully submitted,



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Version with Markings to Show Changes Made

In the claims:

Amend the claims as follows. All pending claims are listed below, whether amended or not, for the Examiner's convenience.

1. (unchanged) An electro-acoustic system for use with electronic sound-generating equipment, comprising:

- an fitted earmold having a sound-conduction bore extending therethrough;
- a sound-conducting tube having a passage with one end of the tubing connected to the earmold so that the passage is opposite the sound-conduction bore and, a curved portion adapted to extend along a person's head between the person's head and an ear;
- a speaker acoustically coupled to the other end of the sound-conduction tube for conducting sound into the passage;
- an electrical cable having one end connected to the speaker for driving the speaker; and
- an electrical plug connected to another end of the electrical cable for electrical connection to the electronic sound-generating member.

2. (Amended) An electro-acoustic system as in claim 1, in which the speaker is acoustically coupled to the other end of the sound conduction tube by a [sound conduction tube] housing, said housing snugly engaging said sound conduction tube and said electrical cable.

3. (unchanged) An electro-acoustic system as in claim 1, where a connector has an inner end including a passage connected to the sound-conduction bore, and an outer end connected to the one end of the sound-conduction tube for conducting sound from the sound-conduction tube to the sound-conduction bore.

4. (unchanged) An electro-acoustic system as in claim 3, wherein the sound-conduction bore has an entry section and an exit section.

5. (unchanged) An electro-acoustic system as in claim 4, wherein a seating member is disposed in the entry section.

6. (unchanged) An electro-acoustic system as in claim 5, wherein the connector has an elbow configuration and includes a tubing-receiving section, a latching section and a sound-conduction tubular passage extending from the tubing-receiving section to an outer end of the latching section, the latching section mating with the seating member to latchably secure the connector in the entry section of the sound-conduction bore.

7. (unchanged) An electro-acoustic system as in claim 6, wherein the tubing-receiving section has a diameter to receive the other end of the sound-conduction tubing.

8. (unchanged) An electro-acoustic system as in claim 6, wherein an internal diameter of the sound-conduction tubing, the diameter of the sound-conduction tubular passage, and the diameter of the exit section of the sound-conduction bore are the same therealong.

9. (unchanged) An electro-acoustic system as in claim 7, wherein a filter is disposed in the tubing-receiving section adjacent the other end of the sound-conduction tubing.

10. (unchanged) An electro-acoustic system as in claim 9, wherein the tubing-receiving section has a shoulder against which the filter engages.

11. (unchanged) An electro-acoustic system as in claim 5, wherein the seating member has an annular section disposed in the entry section and an annular shoulder disposed against the earmold.

12. (unchanged) An electro-acoustic system as in claim 6, wherein the latching section has an annular recess, and an annular barb located in the annular recess for engaging the inner surface of the seating member.

13. (unchanged) An electro-acoustic system as in claim 6, wherein a space is provided in the entry section between an inner end of the seating member and an inner surface of the entry section, and a nubbin of the latching section is disposed within the space.

14. (unchanged) An electro-acoustic system as in claim 1, wherein the electrical cable has a coiled section.

15. (Amended) An electro-acoustic system as in claim 1, wherein the electrical cable has an electrical connector [therein] attached thereto.